

REMARKS

The Examiner has rejected claims 12, 13, 15 and 17 under 35 USC 102 as anticipated by Bahar and claim 16 under 35 USC 103 as unpatentable over Bahar in view of Queen. Applicant has cancelled claims 13, 15 and 16. Applicant respectfully disagrees with the rejection of the cancelled claims, and this cancellation is made without prejudice to the content of those claims.

While claim 15 has been cancelled, the Examiner's manner of intermixing words such as a "box," a "linear edge" and a "straight edge" in explaining this rejection, as well as the Examiner's arguments in an earlier office action in an effort to distinguish a "straight edge" from a "straightedge," are pertinent to the allowability of the amended and added claims now pending in this prosecution.

Claims 12 and 17 have been amended to clarify, and added claims 18 and 19 assert, that Applicant's tool is a "straightedge" which has an "edge" with a "lengthwise cavity." This is in keeping with Applicant's specification which shows a straightedge (Figs. 1-5, 10-14) and uses the term "straight edge" as the noun identifying the tool (p5, ln 6, 7, 8, 10, 11, 22, 24, 27; p7, ln 2, 3, 5, 6; p9, ln 8, 10, 12, 17; p 10, ln 5, 8, 10) as what the Examiner calls a straightedge. Applicant also uses the term "edge" (p7, ln 4, 21, 23, 25; p 8, ln 3, 16, 24, 25, 27; p 9, ln 2, 6, 7, 18, 19; p 10, ln 2) in distinguishing the testing edge of the straightedge as part of the straightedge.

None of Applicant's pending claims are anticipated by Bahar. Bahar is a box 10, not a straightedge. Bahar does not have a straight or linear edge 21; it has several straight or linear edges 21, none of which have a lengthwise cavity. Bahar's straight or linear edges 21, taken together, define a box 10 and the box 10, not the edges 21, has a cavity.

Claims 12, 18 and 19 as amended are further distinguished over Bahar in that they require a light source chamber remote from the cavity with passages or means for conducting light from the chamber to the cavity.

Applicant disagrees with the Examiner's reliance on *Kropa* to deny patentable weight to the preamble of Applicant's claims. 35 USC 112 requires that enabling disclosure be made to those skilled in the art. Machinists know what is involved in "identifying flaws in flatness of a surface of a workpiece" and the context of the remainder of the claims must be viewed in light of this special characterization of the claimed invention. See *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 62 USPQ2d 1281 (FedCir 2002).

Applicant disagrees with the Examiner's refusal to give the language "for abutment with the workpiece to be tested" since this language makes clear that the edge that has the cavity is the edge that will abut the workpiece. Moreover, Applicant disagrees with the Examiner's reliance on *Ex parte Masham* for refusing patentable weight to this and other language in the claims. For example, a box is incapable of identifying flaws in a surface while a straightedge is incapable of leveling tiles, as Applicant has explained in detail in earlier communications in this prosecution. See *Plastic Container Corporation v. Continental Plastics of Oklahoma*, 607 F.2d 885, 203 USPQ 27 (CA10 1979).

Applicant disagrees with Examiner's reliance on *In re Mason* to deny any patentable weight to Applicant's "whereby" statements. The whereby statements, for example, add to the distinction between a straightedge and a box. Applicant is not required to put a dimension on the thickness of a straightedge. If a tool is thin enough for use in a machinist's trade to determine surface flatness, it is too thin for a tile layer to determine whether tiles are in a parallel plane. The ability of the edge to test in a linear rather than planar manner is essential to the invention and this language serves this purpose. See *Steven M. Hoffer v. Microsoft Corporation*, 405 F.3d 1329 (Fed.Cir.2005) 74 USPQ2d 1481.

Applicant respectfully submits that all claims pending after this amendment are distinguished over Bahar and allowance of all claims is respectfully requested.

It is understood there is no fee due at this time. However, should a fee deficiency have occurred, please charge Deposit Account No. 50-1971 per 37 C.F.R. § 1.25.

Respectfully submitted,



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